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EXAMINER
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PRICE, CARL D

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 08/08/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/935,483

Applicant(s)

SHIMEK ET AL.

Examiner

CARL D. PRICE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 and 33-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31,33-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

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**Reissue Application**

**Applicant's continuing obligation under 37 CFR 1.178(b)**

Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,941,237 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

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**Summary of Claims**

Claims 32 and 41-55 have been cancelled.

Original patented claims 1-14, 16 and 18 are unchanged.

Previously added claims 19-28, 30, 31, and 39 are unchanged.

Claims 15, 17, 29, 33, 35 and 36-38, and 40 are have been amended by applicant.

**Response to Arguments**

Applicant's arguments filed 06-09-2003 have been fully considered but they are not persuasive.

**Applicant remarks regarding the Double Patenting rejection**

Applicant argues the Double Patenting rejection on grounds that “the present application has a priority date (January 19, 1996) that predates the priority dates of both the ‘575 and ‘481 patents”. Applicant arrives at the conclusion that:

“Since the present application has an earlier priority date, the reissue patent granted from the present application will therefore expire prior to either of the ‘575 and ‘481 patent. Consequently, it is respectfully submitted that there is no term of the reissue patent which will issue from the present application which will extend beyond the ‘575 and ‘481 patents to disclaim.”.

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Applicant's analysis of the presumed patent term of the present application with regard to the '575 and '481 patent terms is noted. However, applicant's attention is directed to M.P.E.P. 804 which discusses the purpose and rationale for Double Patenting, portions of which are reprinted hereinbelow.

804 Definition of Double Patenting:

"The doctrine of double patenting seeks to prevent the unjustified extension of patent exclusivity beyond the term of a patent. The public policy behind this doctrine is that:

The public should . . . be able to act on the assumption that upon the expiration of the patent it will be free to use not only the invention claimed in the patent but also modifications or variants which would have been obvious to those of ordinary skill in the art at the time the invention was made, taking into account the skill in the art and prior art other than the invention claimed in the issued patent.

In *re* Zickendraht, 319 F.2d 225, 232, 138 USPQ 22, 27 (CCPA 1963) (Rich, J., concurring). Double patenting results when the right to exclude granted by a first patent is unjustly extended by the grant of a later issued patent or patents. In *re* Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982)."

And,

"Double patenting may exist between an issued patent and an application filed by the same inventive entity, or by an inventive entity having a common inventor with the patent, and/or by the owner of the patent. Since the inventor/patent owner has already secured the issuance of a first patent, the examiner must determine whether the grant of a second patent would give rise to an unjustified extension of the rights granted in the first patent. A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re White*, 405 F.2d 904, 160 USPQ 417 (CCPA 1969); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); *In re Sarett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964)."

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And,

“A. Between Issued Patent and One or More Applications

Double patenting may exist between an issued patent and an application filed by the same inventive entity, or by an inventive entity having a common inventor with the patent, and/or by the owner of the patent. Since the inventor/patent owner has already secured the issuance of a first patent, the examiner must determine whether the grant of a second patent would give rise to an unjustified extension of the rights granted in the first patent.”

“B. Nonstatutory Double Patenting

A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re White, 405 F.2d 904, 160 USPQ 417 (CCPA 1969); In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); In re Sarett, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964).”

And,

“(b) Two-Way Obviousness

If the patent is the later filed application, the question of whether the timewise extension of the right to exclude granted by a patent is justified or unjustified must be addressed. A two-way test is to be applied only when the applicant could not have filed the claims in a single application and there is administrative delay. In re Berg, 46 USPQ2d 1226 (Fed. Cir. 1998) (“The two-way exception can only apply when the applicant could not avoid separate filings, and even then, only if the PTO controlled the rates of prosecution to cause the later filed species claims to issue before the claims for a genus in an earlier application . . . In Berg's case, the two applications could have been filed as one, so it is irrelevant to our disposition who actually controlled the respective rates of prosecution.”). In the absence of administrative delay, a one-way test is appropriate. In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993) (applicant's voluntary decision to obtain early issuance of claims directed to a species and to pursue prosecution of previously rejected genus claims in a continuation is a considered election to postpone by the applicant and not administrative delay). . . .”

The examiner's position regarding the rejection of the claims under nonstatutory double patenting rejection, based on a judicially created doctrine grounded in public

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policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees, is unchanged.

**Applicant's arguments regarding: Improper Recapture Rejections**

Applicant assumes that claim 19 was inadvertently listed in the rejection, since claim 19 was listed on the PTO FORM 326 "Office Action Summary" (PTO FORM 326) as being allowed, and is therefore not subject to the recapture rejection. Applicant is correct that claim 19 is not subject to the recapture doctrine.

Applicant argues that the invention of claims 20-31 and 33-40 are not subject to recapture "because the claims are directed to inventions that are distinct from the inventions originally claimed in U.S. Patent No.- 5,941,237", specifically apparatus claim 8. Applicant further argues that the claims of the original patent are directed to a combustion chamber comprising a plurality of panels, not a one-piece combustion chamber as in the present application.

Applicant is reminded that the mere fact applicant has narrowed some aspects of the claimed invention does not preclude a rejection of the claims under the doctrine of recapture. See M.P.E.P. 1412.02.

**1412.02 Recapture of Canceled Subject Matter**

A reissue will not be granted to "recapture" claimed subject matter that was surrendered in an application to obtain the original patent. *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289,

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295 (Fed. Cir. 1984); In re Wadlinger, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974); In re Richman, 409 F.2d 269, 276, 161 USPQ 359, 363-364 (CCPA 1969); In re Willingham, 282 F.2d 353, 127 USPQ 211 (CCPA 1960).

**TWO STEP TEST FOR RECAPTURE:**

In Clement, 131 F.3d at 1468-69, 45 USPQ2d at 1164, the Court of Appeals for the Federal Circuit set forth guidance for recapture as follows:

The first step in applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the patent claims. For example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation's aspect.... Under Mentor [Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 994, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993)], courts must determine in which aspects the reissue claim is broader, which includes broadening as a result of an omitted limitation....

**CRITERIA FOR DETERMINING THAT SUBJECT MATTER HAS REISSUE CLAIMS ARE BROADER IN SCOPE IN SOME ASPECTS, BUT NARROWER IN OTHERS:**

Reissue claims that are broader in certain aspects and narrower in others vis- à-vis claims canceled from the original application to obtain a patent may avoid the effect of the recapture rule if the claims are broader in a way that does not attempt to reclaim what was surrendered earlier. Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 994, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). "[I]f the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; [] if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible." Clement, 131 F.3d at 1470, 45 USPQ2d at 1165. If the broadening aspect of the reissue claim relates to subject matter previously surrendered, the examiner must determine whether the newly added narrowing limitation in the reissue claim modifies the claim such that the scope of the claim no longer results in a recapture of the surrendered subject matter. If the narrowing limitation modifies the claim in such a manner that the scope of the claim no longer results in a recapture of the surrendered subject matter, then there is no recapture. In this situation, even though a rejection based on recapture is not made, the examiner should make of record the reason(s) why, as a result of the narrowing limitation, there is no recapture.

It is the examiner's position that the newly added narrowing limitation (e.g. one-piece) in the reissue claim does not modify the claim such that the scope of the claim no longer results in a recapture of the surrendered subject matter.



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**Applicant's remarks regarding the rejection of claims under 35 USC 102**

It is noted that while applicant's remarks reference Great Britain Patent Application No. 2 236 315A, actual reference characters and text referenced by applicant correspond to Lamb et al Great Britain Patent Application No. 2 257 783A which forms the basis of the examiner's rejection of the claims.

Applicant argues that Lamb et al is directed to a and improved fireback for use in a fireplace and can not function independently as a combustion chamber as recited by claim 20, since it requires and outer casing of steel. It is the examiner's position however that Lam et al '783 anticipates the structure of a the broadly defined combustion chamber recited in applicant's claim 20. Applicant's claim 20, does not preclude the use of an outer casing as in Lamb et al '783. Indeed, applicant's characterization of the open box as "a combustion chamber" is deemed merely as statement of intended use which is given no patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the case of Lam et al, it is noted however that, the open shallow box, does indeed act as a chamber in which combustion occurs, due to the placement of a burner "relative" to the floor panel "whereby flames from the burner will be drawn upwards and through the simulated fuel on the support bed therefor" (see page 3, lines 1-

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3). Thus, the “fireback” of Lamb et al, defines a combustion chamber in a manner not unlike that intended by applicant.

In regard to applicant’s argument that Lamb et al ‘783 does not include a “top panel” applicant’s attention is directed to element the planar upper section (30) of Lamb et al ‘783 which forms a “top panel”, albeit a short panel, in the manner broadly recited in applicant’s claim 29.

**Applicant’s remarks regarding the rejection of claims under 35 USC 103**

Applicant argues the rejection of claims under 35 U.S.C. 103(a) as being unpatentable over Shimek et al (U.S. Patent No. 4,793,322) in view of Lamb et al (UK 2 257 783), Rex, Jr. et al (U.S. Patent No. 3,100,734) or Champion. In response to applicant's arguments against the references individually (i.e. - that none of the prior art references disclose a one-piece combustion chamber) one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

**Restriction Requirement**

Applicant's election with traverse of the restriction requirement in Paper No. 8 is acknowledged. However applicant did not distinctly and specifically point out the supposed errors in the restriction requirement.

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The requirement is still deemed proper and is therefore made FINAL.

Cancellation of non-elected claims 41-55 is acknowledged.

**Reissue Oath/Declaration**

Submission of the declarations newly executed by both applicants is acknowledged. The newly submitted reissue declarations include the necessary information to overcome the previous noted defects in the original declarations filed by applicants.

**Offer to Surrender**

Applicant's offer to surrender the original patent is acknowledged. The original patent, or statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed.

**Supplemental reissue oath/declaration under 37 CFR 1.175(b)(1)**

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

**Claims 1-31,33-40 are rejected as being based upon a defective reissue declaration**

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

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Claims 1-31 and 33-40 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

### **Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,2,4,19,20,24-26,28-31,33,35-37,40 and 52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 14, 16 and 17 of U.S. Patent No. 5,996,575. Although the conflicting claims are not identical, they

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are not patentably distinct from each other because it would have been obvious to a person having ordinary skill in the art that the scope of the more broadly recited invention set forth in claims 1,2,4,19,20,24-26,28-33,35-37,40 and 52 of the present application would be encompassed within the scope of the more narrowly defined invention set forth in claims 1, 14, 16 and 17 of U.S. Patent No. 5,996,575.

Claims 1,19,29 and 52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2,9,10 and 16 of U.S. Patent No. 6,170,481. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to a person having ordinary skill in the art that the scope of the more broadly recited invention set forth in claims 1, 2,9,10 and 16 of the present application would be encompassed within the scope of the more narrowly defined invention set forth in claims 1, 2,9,10 and 16 of U.S. Patent No. 6,170,481.

Claims 1,8,9,19,20,26 and 52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-10 of U.S. Patent No. 5,647,340. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to a person having ordinary skill in the art that the scope of the more broadly recited invention set forth in claims 1,8,9,19,20,26 and 52 of the present application would be encompassed within the scope of the more narrowly defined invention set forth in claims 7-10 of U.S. Patent No. 5,647,340.

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**Improper recapture**

Claims 20-31 and 33-40 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue that was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claims 20-31 and 33-40 do not include the following limitations added by amendment to the claims during the prosecution of the original application.

Claims 20-28 do not include:

- 1) “universal open box”,
- 2) “two side panels”,
- 3) “dried after molding”,
- 4) “impact resistant box of panels of a fireplace”,
- 5) “glass door means attached to said panels”,
- 6) “a gas tight closed box fireplace”.

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7) “burner means supported by said floor panels”,

Claims 29-31 do not include:

- 1) “universal open box”.
- 2) “two side panels”,
- 3) “impact resistant box of panels of a fireplace”,
- 4) “burner means supported by said floor panels”,
- 5) “glass door means attached to said panels”,
- 6) “gas tight closed box fireplace”.

Claims 33-40 do not include:

- 1) “two side panels”,
- 2) “universal open box”,
- 3) “burner means supported by said floor panels”,
- 4) “glass door means attached to said panels”.

Claim 52 does not include:

- 1) “inorganic binder”,
- 2) “fireplace combustion chamber having an open side for supporting door means  
and”,

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- 3) “an uncured stiff one piece”,
- 4) “a rigid combustion chamber ready for assembly of said door means and gas burner to form a unique fireplace “.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20,21,29,30,37,40 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Lamb et al (GB 2 257 783).

Lamb et al ‘783 show and disclose an a one-piece rigid, or stiff, open box combustion chamber (figure 2) having sidewalls (20) and a bottom (19) rear wall (18) and top wall (30), combustion chamber The combustion chamber of Lamb et al being made by the method of 1) molding an aqueous slurry of ceramic fiber (see page 1, line 20 - page 2, line 3) and an inorganic binder (i.e. – silica; see page 2, line 6), 2) removing the molded chamber from the mold followed by 3) drying “with or without heat” (see page 2, line 4). A burner (not shown; see page 3, line 14) is positioned on a bottom wall (16) and relative to the floor panel (19) to provide a flame within the chamber. A front panel (12) coupled to the firebox.



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**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20 –31,33- 40 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimek et al (U.S. Patent No. 4,793,322) in view of Lamb et al (UK 2 257 783), Rex, Jr. et al (U.S. Patent No. 3,100,734) or Champion.

Shimek et al show and disclose a refractory panel open box combustion chamber (figure 2) having sidewalls (24,25) and a refractory material bottom panel (80) and rear wall (26). A burner (62) is positioned on and through an opening in the refractory material bottom panel and relative thereto to provide a flame within the chamber. A front panel (at 81) coupled to the firebox. The bottom portion (45,48,75) provides fluid communication of combustible gas to the aperture.

Lamb et al show and disclose an a one-piece rigid, or stiff, open box combustion chamber (figure 2) having sidewalls (20) and a bottom (19) rear wall (18) and top wall (30). The combustion chamber of Lamb et al being made by the method of 1) molding an aqueous slurry of ceramic fiber (see page 1, line 20 - page 2, line 3) and an inorganic binder (i.e. – silica; see page 2, line 6), 2) removing the molded chamber from the mold followed by 3) drying “with or without heat” (see page 2, line 4). A burner (not shown; see page 3, line 14) is positioned on a

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bottom wall (16) and relative to the floor panel (19) to provide a flame within the chamber. A front panel (12) coupled to the firebox.

Champion shows (figure 1) a one-piece open box refractory material combustion chamber (15) having sidewalls (33,34) and a bottom (30) rear wall (31) and top wall (32). The bottom wall of the combustion chamber of Champion supports a wood log type burner

Rex, Jr. et al show and disclose a combustion chamber (figure 1) having sidewalls and a bottom (not referenced). The “self supporting”, rigid or stiff, combustion chamber (see column 2, lines 40-41) of Rex, Jr. et al being made by the method of 1) vacuum molding ceramic fiber, mixed with an aqueous solution water and an “inorganic” binder (see column 2, lines 7-8; “These fibers are placed in a tank of water with colloidal silica), 2) removing the molded chamber from the mold followed by 3) thorough drying. The combustion chamber is then heated in the furnace after installation to temperatures “up to 2300” degrees F.

In regard to claims 20 – 31,33-40 and 52, for the purpose of providing a suitable refractory, (e. g. – high temperature heat resistant material) for the combustion chamber, and to simplify assembly of the Shimek et al fireplace, it would have been obvious to a person having ordinary skill in the art to form the combustion chamber of Shimek et al as a one-piece molded member having top, rear, side and bottom walls of the same refractory material, in view of the teachings of Lamb et al, Champion and Rex, Jr. et al. Also, for the purpose of providing a suitable refractory material for the Shimek et al combustion chamber, it would have been

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obvious to a person having ordinary skill in the art to make the one-piece chamber by the method of 1) molding an aqueous slurry of ceramic fiber and an inorganic binder removing the molded chamber from the mold followed by drying in view of the teachings of Lamb et al or Rex, Jr. et al. In regard to claims 22,23,34 and 35, Official Notice is taken that it is well known to use open pan burners as a flame source in simulated log type gas fireplaces. Thus, in view of that which is well known, it would have been obvious to a person having ordinary skill in the art to modify the burner of Shimek et al to be in the form of an open pan type burner.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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***USPTO CONTACT INFORMATION***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARL D. PRICE whose telephone number is 703-308-1953. The examiner can normally be reached on Monday through Friday between 6:30 am-3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 703-308-0101. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1148/0858.

A handwritten signature in black ink, appearing to read 'Carl D. Price', with a large, stylized loop at the end.

CARL D. PRICE  
Primary Examiner  
Art Unit 3743

cp  
August 7, 2003